

REMARKS

In response to the Species Election Requirement, Applicants hereby provisionally elect, with traverse, Species II, corresponding to claims 1-4 and 6-7, for examination on the merits.

It is respectfully submitted that at least claims 1-7 are readable on the elected species.

On page 2 of the Office Action, the Office indicated that Applicants must elect a single species from the following:

Species I - claims 1-5 and 7 - a rail having a composition of carbon, manganese, silicon or aluminium, chromium, and molybdenum; and

Species II - claims 1-4 and 6-7 - a rail having a composition of carbon, manganese, phosphorus, sulphur, aluminum, silicon, chromium, molybdenum, titanium, and boron.

In item 4 of page 3 of the Action, it was indicated that Species I and II do not relate to a single general inventive concept under PCT Rule 13.1, because, under PCT Rule 13.2, the species lack the same corresponding technical on the basis that the two species are defined by substantially different compositions that present two different inventive concepts.

Applicants respectfully traverse this requirement.

First, it is respectfully submitted that the requirement is improper as a matter of law. The present application is a National Stage Application of PCT/FR02/06922. Pursuant to 37 C.F.R. § 1.499, unity of the invention practice

must be followed for a National Stage Application, as described by 37 C.F.R. § 1.475. Accordingly, the Office is required to follow the rules regarding unity of invention in PCT rules 13.1 and 13.2. However, the Office appears to have improperly applied U.S. restriction practice for this application as evident by the rationale given for the restriction and the lack of a proper basis for a determination of lack of unity of invention. See, *Caterpillar Tractor v. Commissioner of Patents and Trademarks*, 650 F. Supp. 218 (E.D. Va 1986). See also M.P.E.P. § 1850.

Second, it is respectfully submitted that had unity of invention been applied, unity would have been found to exist and all of the claims would have been examined together in this application. In this regard, Applicants submit that the Office Action has failed to satisfy its burden in showing that claims lack of unity under the requirements of PCT Rules 13.1 and 13.2.

Determination of the lack of unity is possible only when the claims of different inventions lack a "special technical feature" relative to one another. In the present case, as independent claim 1 is a rail composition generic to the dependent claims, all of the claims of Groups I and II, by definition, share the same special technical features of claim 1.

The Examiner's attention is respectfully directed to PCT Rule 13.2 in Part 1b of the Annex B of the administrative instructions under the PCT, which specifies that "special technical features" are those features that define a contribution

which each of the inventions, considered as a whole, makes over the prior art. In other words, PCT Rule 13.2 is art-based and requires the citation of a publication showing the "special technical feature". Thus, absent any showing that the claimed rail composition is present in a prior art reference, no determination of lack of unity can properly be made.

Therefore, as the Office Action fails to provide such a citation, Applicants believe that the species election requirement is improper as a matter of law.

Third, contrary to the Office's position, the two species are not defined by substantially different compositions. In this regard, the steel defined in claim 6 is only a selection of the more generic definition of the steel in claims 1 and 5. Accordingly, if one of the claims 1-4 is allowable, there would be no problem of unity of invention.

Fourth, it is respectfully submitted that the species are sufficiently closely related that a search and examination of the entire application can be made without a serious burden to the Office. In this regard and as noted above, the steel defined in claim 6 is only a selection of the more generic definition of the steel in claim 5.

Thus, in view of the above, it is believed that Applicants are entitled to an action on the merits of all pending claims, in their full scope, in the present application. Favorable action is respectfully requested.

In the event that the Office disagrees with the traversal and maintains the requirement, then kindly consider and examine additional species, upon allowance of the generic claims, in accordance with U.S. election of species practice.

Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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